

Remarks

This Application has been carefully reviewed in light of the Office Action mailed September 22, 2004. Applicants appreciate the Examiner's consideration of the Application. To clarify various aspects of inventive subject matter, Applicants amend Claims 1, 7, 15, 16, 23, and 33. To advance prosecution of this application, Applicants have responded to each notation by the Examiner. Applicants submit that all of the pending claims are allowable over the cited references. Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections Under 35 U.S.C. § 112

Claim 33 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended Claim 33. Applicants believe this amendment does not narrow the scope of the claim, but address the Examiner's rejections under §112. Applicants respectfully request reconsideration and favorable action in this case.

Rejections Under 35 U.S.C. § 102

The Examiner rejects Claims 1, 2, 7, 8, 13, 16, 18, and 34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,700,840 to Haddock ("Haddock"). Applicants respectfully traverse these claim rejections for at least the reasons discussed below.

Among other features, amended independent Claim 1 recites, in part, "a recess disposed within the identification card, the recess operable to receive an item personally selected by a cardholder of the identification card to customize the identification card according to one or more particular personal preferences of the cardholder, the recess permitting the item to be inserted into and removed from the recess by the cardholder." Amended Claim 1 also recites, in part that "the identification card is operable to identify the cardholder and an issuer of the identification card." In addition, amended Claim 1 also recites, in part, "a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card."

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, “[t]he elements *must* be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (emphasis added).

Haddock fails to teach or suggest a number of elements of amended Claim 1. For example, nowhere does *Haddock* contemplate a recess that permits an item that is personally selected by a cardholder to be inserted into and removed from the recess by the cardholder. Moreover, such recess is disposed within the identification card at a location that is separate from a location on the identification card that a magnetic stripe is disposed. To the extent that *Haddock* discusses a recess or cavity, this discussion is limited to a depression (e.g., depression 53 of Figure 3) located within shelf 45 of drawer 15 and a slot 27 within case 13. See e.g., Col. 2, Lines 37-38; Col. 3, Lines 15-18. For example, nowhere does *Haddock* teach or suggest that depression 53 permits strip 49 to be removed from depression 53 after insertion. In particular, after the strip 49 has been inserted into depression 53, a front cover 55 “is disposed over strip 49. Cover 55 may be a transparent plastic sheet laminating material or a coating, such as a transparent lacquer.” As a result, depression 53 of drawer 15 does not permit strip 49 to be removed after insertion into depression 53. Consequently, *Haddock* fails to teach or suggest “a recess disposed within the identification card, the recess operable to receive an item personally selected by a cardholder of the identification card to customize the identification card according to one or more particular personal preferences of the cardholder, the recess permitting the item to be inserted into and removed from the recess by the cardholder.”

Haddock also fails to teach or suggest an identification card that is operable to identify the cardholder and an issuer of the identification card. Moreover, *Haddock* fails to contemplate a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, where the magnetic stripe is operable to store information. To the extent

that *Haddock* discusses a device capable of storing any information, this discussion is limited to a device (e.g., strip 49) that is disposed within a depression (e.g., depression 53 of Figure 3) within shelf 45 of drawer 15. *See e.g., Col. 3, Lines 15-19.* Indeed, *Haddock* teaches away from a data storage medium disposed separate from depression of drawer 15 by requiring strip 49 to be located within the depression and protected by a scratch resistant and moisture barrier material. *See e.g., Col. 4, Lines 40-65.* Consequently, *Haddock* fails to teach or suggest “a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card.”

Applicants submit that amended independent Claim 1 is patentable over *Haddock* for at least the reasons discussed above. Thus, Applicants respectfully request withdrawal of the rejection and full allowance of amended Claim 1 and all claims depending therefrom.

Applicants submit that amended independent Claims 7 and 16 are patentable over *Haddock* for at least the reasons discussed above. Thus, Applicants respectfully request withdrawal of the rejection and full allowance of amended Claims 7 and 16, and all claims depending therefrom.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejects Claims 23, 24, and 31-34 under 35 U.S.C. § 103(a) as being unpatentable over *Haddock* in view of U.S. Patent 4,159,417 to Rubincam (“*Rubincam*”). The Examiner also rejects Claims 23 and 39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,427,836 to Bolanos (“*Bolanos*”) in view of *Rubincam*. Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Haddock*. The Examiner further rejects Claims 6 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Haddock* in view of U.S. Patent 5,467,871 to DeField (“*DeField*”). Applicants respectfully traverse these claim rejections for the reasons discussed below.

Applicants respectfully submit that the Examiner’s proposed *Haddock-Rubincam* and *Bolanos-Rubincam* combinations fail to support the obviousness rejections for at least three

reasons. First, *Haddock* and *Rubincam* are not analogous art and thus may not properly be used to reject Appellants' claims. Second, even if *Haddock* and *Rubincam* could properly be considered analogous art, the required teaching, suggestion, or motivation to combine at least *Haddock* with *Rubincam* or *Bolanos* with *Rubincam* would still be lacking. Third, even if *Haddock* and *Rubincam* could properly be considered analogous art and also could properly be combined, the proposed combination would still fail to disclose, teach, or suggest each and every limitation specifically recited in the rejected claims.

a. *Haddock* and *Rubincam* are non-analogous art

The proposed *Haddock-Rubincam* and *Bolanos-Rubincam* combinations are improper because *Haddock* and *Rubincam* are not analogous art. The Examiner must determine, with respect to the subject matter at issue, what is analogous art for purposes of the obviousness analysis. M.P.E.P. § 2141.01(a). “In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). A reference in a different field may be reasonably pertinent only if “it is one which because of the matter with which it deals, logically would have commended itself to an inventor's attention when considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1061 (Fed. Cir. 1992). Since neither *Haddock* nor *Rubincam* mention or even remotely allude to an identification card that is “operable to identify the cardholder and an issuer of the identification card,” *Haddock* and *Rubincam* are not in Appellants' field of endeavor and certainly would not have “commended itself” to Appellants when considering the problem addressed by Appellants' invention. Thus, neither *Haddock* nor *Rubincam* can properly be used as a reference against Appellants' claims and these rejections cannot properly be maintained.

b. No suggestion or motivation to combine

Even assuming for the sake of argument that *Haddock* and *Rubincam* could be considered analogous art, which Applicants dispute, and even if it would have been technologically possible to in some way combine the teachings of *Haddock* and *Rubincam* and *Bolanos* and *Rubincam*, which Applicants also dispute, these rejections would still be

improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Haddock*, *Rubincam*, *Bolanos*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Haddock* with *Rubincam* or *Bolanos* with *Rubincam* in the manner the Examiner proposes. The rejected claims are also allowable for at least this reason.

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembicza*k, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).²

In the present case, the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Haddock* and *Rubincam*, and *Bolanos* and *Rubincam*. As provided above, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thus, the mere fact that the teachings of one reference would improve the teachings of another reference as asserted by the Examiner does not provide the required suggestion to combine. The showing must be clear and particular. *See, e.g., C.R. Bard v. M3 Sys., Inc.*, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998). Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200 (Fed. Cir. 1991).

To reject Claim 23 under the proposed combination of *Haddock-Rubincam* or *Bolanos-Rubincam*, the Examiner has made conclusory "it would have been obvious" and "[a]n ordinary artisan would have been motivated" statements. For example, the Examiner has merely stated that "it would have been obvious" to make the proposed combination "for the purpose of storing the picture in a portable means." *See e.g., Office Action at 6*. The Examiner has presented no evidence, however, that suggests or motivates the combination. It is improper for the Examiner to use hindsight having read the Applicants' disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

² *See also In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claim 23, as the Examiner has not show the requisite proof necessary to establish a suggestion or motivation to combine the cited references.

c. **Claim 23 is patentable over Haddock-Rubincam and Bolanos-Rubincam**

Finally, to defeat a patent under 35 U.S.C. § 103, “the prior art reference must teach, disclose, or suggest all the claim limitations.” *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). Applicants respectfully submit that the references cited by the Examiner, taken alone or in combination, teach or suggest, either expressly or inherently, a number of elements of amended independent Claim 23.

Among other features, amended Claim 23 recites, in part, “a recess disposed within the identification card, the recess operable to receive an insert, the recess permitting the insert to be inserted into and removed from the recess by a cardholder of the identification card.” Amended Claim 23 also recites, in part, that “the identification card is operable to identify the cardholder and an issuer of the identification card.” In addition, amended Claim 23 recites, in part, “a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card.”

**Haddock and Rubincam do not teach or suggest
all the limitations of Claim 23**

Applicants submit that amended Claim 23 is patentable over *Haddock* in view of *Rubincam*. For example, as discussed above, nowhere does *Haddock* contemplate “a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card.” Moreover, *Haddock* fails to teach or suggest “a recess disposed within the identification card, the recess operable to receive an insert, the recess

permitting the insert to be inserted into and removed from the recess by a cardholder of the identification card.” Consequently, *Haddock* fails to teach or suggest amended Claim 23.

The teachings of *Rubincam* do not make up for the deficiencies of *Haddock*. For example, nowhere does *Rubincam* contemplate a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, where the magnetic stripe is operable to store information. To the extent that *Rubincam* discusses a device capable of storing any information, this discussion is limited to a device (e.g., holographic card 30) that is capable of storing a plurality of holograms 32. *See e.g., Col. 2, Lines 47-66.* Consequently, *Rubincam* fails to teach or suggest “a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card.”

Moreover, *Rubincam* fails to teach or suggest a recess that permits the item to be inserted into and removed from the recess by the cardholder. Consequently, *Rubincam* fails to teach or suggest “a recess disposed within the identification card, the recess operable to receive an item personally selected by the cardholder of the identification card to customize the identification card according to one or more particular personal preferences of the cardholder, the recess permitting the item to be inserted into and removed from the recess by the cardholder.”

For at least these reasons, Applicants submit that *Haddock* and *Rubincam*, taken alone or in combination, fail to teach or suggest amended Claim 23. Applicants respectfully request withdrawal of the rejection and full allowance of amended independent Claim 23 and all claims depending therefrom.

Bolanos and Rubincam do not teach or suggest
all the limitations of Claim 23

Applicants submit that amended Claim 23 is patentable over *Bolanos* in view of *Rubincam*. For example, nowhere does *Bolanos* contemplate a magnetic stripe disposed on

the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, where the magnetic stripe is operable to store information. Consequently, *Bolanos* fails to teach or suggest “a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card.”

The teachings of *Rubincam* do not make up for the deficiencies of *Bolanos*. For example, as discussed above, nowhere does *Rubincam* contemplate a magnetic stripe disposed on the identification card at a location on the identification card that is separate from a location of the recess disposed within the identification card, where the magnetic stripe is operable to store information. Moreover, *Rubincam* fails to teach or suggest a recess that permits the item to be inserted into and removed from the recess by the cardholder. Consequently, *Rubincam* fails to teach or suggest amended Claim 23.

For at least these reasons, Applicants submit that *Bolanos* and *Rubincam*, taken alone or in combination, fail to teach or suggest amended Claim 23. Applicants respectfully request withdrawal of the rejection and full allowance of amended independent Claim 23 and all claims depending therefrom.

No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the *Haddock*, *Rubincam*, and *Bolanos* references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

Conclusion

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Although no fees are believed to be currently due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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